



Xerox Docket No. D/A1209

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Chi-Thanh DANG et al.

Group Art Unit: 2176

Application No.: 09/859,425

Examiner: P. Smith

Filed: May 18, 2001

Docket No.: 109444

For: SYSTEMS AND METHODS FOR DYNAMIC NATIONAL LANGUAGE SERVICE

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed herewith, a pre-appeal brief conference is respectfully requested.

The rejection of claim 21 under 35 U.S.C. §101 will be challenged on Appeal. The March 17, 2005 Advisory Action states that the amendments made by the March 4 Amendment After Final Rejection ("the AAFR") will be entered for the purposes of Appeal. Based on the amendment to claim 21 and the remarks set forth in the AAFR, Applicants contend that claim 21 recites statutory subject matter.

The rejection of claims 1-21 under 35 U.S.C. §103(a) over U.S. Patent No. 6,421,733 to Tso et al. ("Tso") in view of U.S. Patent No. 6,073,147 to Chan et al. ("Chan") will also be challenged on Appeal.

Applicants contend that the interpretation of Chan set forth in the January 4 Final Office Action and the Advisory Action is erroneous. As such, Chan does not teach the features alleged by the Examiner and does not suggest the modification of Tso alleged by the Examiner.

Specifically, Chan does not teach "maintaining both graphical and outline versions of text characters" in column 3, lines 36-45. Chan teaches storage of available fonts for characters in documents; that is, the font resource distribution system of Chan stores "information which describes each character in the font." Col. 3, lns. 34-36. In other words, the font resource server of Chan stores and provides the necessary information pertaining to the various types of fonts that may be required by users to generate characters present in a document. Although the information may describe the characters of a font in multiple formats, such as a bitmap form and an outline form, the information for generating characters, not the characters, is stored according to Chan. See column 2, lines 5-22.

Chan specifically distinguishes between the characters and the information describing the characters (the font). For example, Chan teaches that transmission time and memory requirements may be reduced by not including font information in the documents. However, the documents certainly include the characters. Thus, it is incorrect and unreasonable to consider the storage of font information by Chan to teach or suggest storage of characters.

Both the Final Office Action and the Advisory Action mischaracterize Chan to allege a motivation to modify the teachings of Tso. The Final Office Action asserts that Chan teaches, in column 4, lines 10-29, "that a graphic glyph is transmitted to client computers for font characters which the client computer cannot display." However, this text of Chan teaches that if the resources necessary to generate a particular font are not stored at the client computer, a request for the necessary resources is transmitted to the font server. The Advisory Action similarly incorrectly asserts that Chan provides graphical and text characters to the client.

Thus, the alleged motivation stated in both the Final Office Action and the Advisory Action is improper and not supported by the teachings of the references. It is respectfully submitted that a combination of the teachings of Tso and Chan would not result in the modification alleged by the Final Office Action. That is, because Chan does not teach storing both graphical content elements and textual content elements, Chan cannot supply the feature of

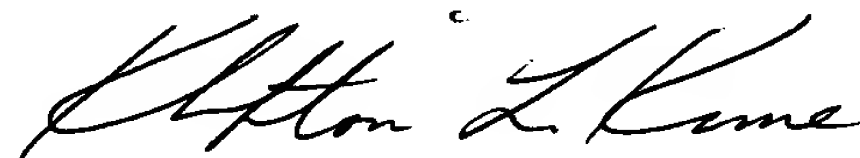
claim 1 admittedly missing from Tso, even if the font information (resources) of Chan were to be stored in the same memory.

Therefore, based on the foregoing remarks and the remarks set forth in the AAFR, Applicants contend that claims 1-21 are patentable over any permissible combination of Tso and Chan.

For the reasons set forth above, reconsideration of the Examiner's position is respectfully requested well prior to the June 4, 2005 deadline for filing an Appeal Brief.

The undersigned attorney respectfully requests to attend the pre-appeal brief conference to answer any questions that might arise regarding Applicants' position, and to consider any possible amendments to the claims that may simplify the Appeal or avoid the need for consideration by the Board of Patent Appeals and Interferences. Further, should the Examiners believe that any further comments or clarification would be helpful to resolve the disputed issues in the pre-appeal brief conference, the Examiners are invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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